



UNITED STATES
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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
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MAY 22 2003

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#30

In re Application of	:
W. Roy Knowles	:
Serial No.: 09/619,142	: PETITION DECISION
Filed: July 19, 2000	:
Attorney Docket No.:	:

This is in response to the petition under 37 CFR 1.181, filed March 29, 2003, requesting that the application be forwarded to the Board of Patent Appeals and Interferences.

BACKGROUND

A review of the file history shows that this application was filed on July 19, 2000. A first Office action was mailed to applicant on October 31, 2000, in which claim 12 was rejected under 35 U.S.C. 112, second paragraph, as indefinite and incomplete; claims 1-4, 8-15 and 19-22 were rejected under 35 U.S.C. 102(e) and (b) as anticipated over Bradbury et al or Bazzano; and claims 1-22 were rejected under 35 U.S.C. 103(a) as unpatentable over Hoke in view of Orentreich et al. Applicant replied on February 7, 2001, including affidavits under 37 CFR 1.131 and 1.132 to overcome the rejections. No amendments to the claims were made.

The examiner mailed a Final Office action to applicant on March 27, 2001, rejecting claims 1-4, 8-10, 12 and 14 under 35 U.S.C. 102(b) as anticipated by Rajadhyaksha et al; claims 1-4, 8-10, 12-15 and 19-21 under 35 U.S.C. 102(b) as anticipated by Bazzano et al; and claims 1-22 under 35 U.S.C. 103(a) as unpatentable over Hoke in view of Orentreich et al. Applicant filed a Notice of Appeal and an Appeal Brief on April 30, 2001, responding to each of the rejections. An interview with the examiner was held on August 9, 2001, with both the examiner and applicant providing a record thereof. Some agreement for reconsideration appears to have been reached.

The examiner mailed a new non-final Office action to applicant on September 28, 2001 (remailed November 7, 2001), in which claims 5, 7, 16 and 18 were newly rejected under 35 U.S.C. 112, second paragraph as indefinite; claims 1-4, 8-10, 12-15 and 19-21 were rejected under 35 U.S.C. 102(b) as anticipated by Bazzano et al; claims 1, 3, 11-12, 14 and 22 were rejected under 35 U.S.C. 102(b) as anticipated by Bradbury et al; claims 1, 3, 12 and 14 were rejected under 35 U.S.C. 102(b) as anticipated by Partain III et al or Rajadhyaksha et al; claims 1-5, 7-11, 12-16

and 18-22 were rejected under 35 U.S.C. 103(a) as unpatentable over Hoke, alone, or in view of Bradbury et al or Rajadhyaksha et al; claims 11 and 22 were rejected under 35 U.S.C. 103(a) as unpatentable over Rajadhyaksha et al in view of Bazzano et al; and claims 6 and 17 were indicated allowable. Applicant replied on January 10, 2002, by canceling claims 6 and 17 and amending claims 1-2, 4-5, 7-10, 15-16 and 18 and replying to the rejections of record and supplying a new affidavit.

The examiner mailed a new Final Office action to applicant on May 9, 2002, in which claims 1, 3, 12 and 14 were rejected under 35 U.S.C. 102(b) as anticipated by Gibson; claims 1-2 and 12-13 were rejected under 35 U.S.C. 102(e) as anticipated by Crandall; claims 1-4 and 12-15 were rejected under 35 U.S.C. 102(e) as anticipated by Roentsch et al; claims 5, 7-10, 16 and 18-21 were rejected under 35 U.S.C. 103(a) as unpatentable over Roentsch et al in view of Crandall; and claims 11 and 22 were rejected under 35 U.S.C. 103(a) as unpatentable over Roentsch et al in view of Grollier et al. Applicant replied by filing a Notice of Appeal on June 21, 2002, and an Appeal Brief on June 28, 2002.

On February 20, 2003, the examiner mailed a new Final Office action to applicant setting forth a new rejection under 35 U.S.C. 112, first paragraph for lack of written description in the specification for claims 1-5, 7-16 and 18-22 which were considered to contain new matter. Claims 1, 3, 12 and 14 were rejected under 35 U.S.C. 102(b) as anticipated by Gibson; claims 1-4 and 12-15 were rejected under 35 U.S.C. 102(b) as anticipated by Bazzano; Claims 1-2 and 12-13 were rejected under 35 U.S.C. 102(b) as anticipated by Zupan; claims 2, 4-5, 7-10, 13, 15-16 and 18-21 were rejected under 35 U.S.C. 103(a) as unpatentable over Gibson in view of Bazzano or Schostarez; claims 11 and 22 were rejected under 35 U.S.C. 103(a) as unpatentable over Bazzano in view of Grolier et al.

Applicant filed this petition on March 29, 2003, seeking to have the application forwarded to the Board of Appeals for consideration.

DISCUSSION

Applicant petitions to have the above identified application forwarded to the Board of Patent Appeals and Interferences based on the record as it presently exists. The prosecution history is noted above. It is noted that at least one rejection was initially made and repeated through the first three Office actions and then withdrawn (by not being repeated) and then reinstated in the last Office action. Also, each of the third, fourth and fifth Office actions contain new grounds of rejection. Some of these grounds may have been necessitated by applicant's amendments and/or arguments. Further consideration of affidavits under 37 CFR 1.131 and 1.132 appears to have been inconsistent with references being applied in later Office actions which would appear to have been disqualified by the affidavit under 37 CFR 1.131. Thus the issues in this application do not appear to have been fully developed by the examiner.

Applicant argues that the examiner is preventing consideration of this application by the Board of Appeals by consistently reopening prosecution, changing the grounds of rejection and refusing to write a "Reply Brief" (sic - Examiner's Answer). The Board of Appeals and Patent Interferences is a reviewing body and does not accept applications for review unless both parties have provided appropriate arguments in the form of an Appeal Brief and Examiner's Answer. Nor will the Board accept applications for review unless all of the issues have been fully developed and argued

by both parties. In this instance, although applicant has twice provided an Appeal Brief, the examiner discovered that all of the issues were not developed and therefor reopened prosecution. In some instances the new issues related to a new understanding of what was being claimed and how a reference could be applied, as evidenced by several new prior art rejections in the third, fourth and fifth Office actions and especially a new rejection under 35 U.S.C. 112, first paragraph, for lack of written description in the last Office action.

Applicant also argues that the examiner is attempting by her actions to alter the existing prosecution file and specifically requests that the examiner be prevented "from contesting the validity of any amendment, declaration or other submission entered into the file". There is no evidence that the examiner has in any way altered the papers in the application file or prohibited entry of any papers. All amendments submitted and all papers and affidavits have been properly entered and considered. It is required of the examiner to carefully consider and evaluate any affidavit submitted in an application and assess its relationship to any reference applied and/or any claim of unexpected results. The examiner has done this properly in the last Office action. It is an inherent examiner's duty to evaluate each and every affidavit and/or amendment entered in the file. This what the term "examination" means. To ask that an examiner be prevented from examining (testing or contesting validity of an affidavit or amendment) violates the basic requirements of the examining position.

Applicant makes several other statements, the validity of which is questioned. Applicant states (page 3) that the examiner has disregarded M.P.E.P. guidelines in not acting on the (second) appeal within two months, but delayed for an entire year. Such is factually incorrect. The longest duration of time between an applicant submission and subsequent action, in any instance, was less than 8 months (6/28/02 to 2/20/03) and the delay in part was occasioned by a petition which was required to be decided before the examiner could act on the case. All other replies have been answered by a new Office action in four months or less from mail room receipt date.

Applicant also attempts to instruct the Board with respect to rejections not maintained by the examiner and to make its decision within 60 days from the filing date of this petition. Such attempted instruction is both inappropriate and improper and is disregarded.

The only action of the examiner which could be construed to be improper is the making Final the fourth and/or fifth Office action because of new rejections raised which were not necessitated by any amendment by applicant. It is especially noted that the fifth Office action contains several rejections over examiner cited new prior art. In view of M.P.E.P. 706.07(a) the last Office action should not have been made Final.

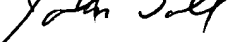
DECISION

Applicants' petition is **DENIED** with respect to the request to forward the application to the Board of Appeals for consideration for the reasons set forth above.

However, although applicant did not request such, the finality of the last Office action is withdrawn in view of the new prior art rejections made which were not necessitated by applicant's reply immediately prior thereto. Applicant, however, remains under obligation to reply to that Office action within the time period set therein, or as may be extended under 37 CFR 1.136(a). Such reply may take the form of an amendment under 37 CFR

1.112 or an Appeal Brief if applicant is of the opinion that all issues which should be considered by the Board have been fully developed.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.

John Doll 
Director, Technology Center 1600



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